



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,769	04/02/2004	Daisuke Yahata	360842009710	9944

7590 12/15/2006

Barry E. Bretschneider  
Morrison & Foerster LLP  
Suite 300  
1650 Tysons Boulevard  
McLean, VA 22102

EXAMINER
----------

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/815,769

Applicant(s)

YAHATA ET AL.

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Response to Amendment***

2. Applicant's amendment filed October 3, 2006, has been entered. Claim 24 has been amended as requested. Claims 1-21 and 25-29 are cancelled. The pending claims are 22-24.

3. Said amendment is sufficient to overcome the 112, 2<sup>nd</sup> rejection of claim 24 as set forth in section 5 of the last Office Action.

### ***Inventorship***

4. In view of the papers filed October 3, 2006, the inventorship in this nonprovisional application has been changed by the deletion of Daisuke YAHATA, Shinnichi NISHIHATA, Motokatsu NISHIMURA, Tatsuro MIZUKI, and Kenso KUBO.

5. The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 22-24 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in section 6 of the last Office Action.

8. Applicant traverses said rejection by asserting the use of functional language in a claim is proper (Amendment, page 3, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs). The examiner agrees that functional language, in and of itself, does not render a claim indefinite. However, the present claim language merely sets forth physical characteristics desired in the yarn rather than the specific composition or structure that produces said physical characteristics. This renders the claim indefinite since it is not clear that the scope of the claim is limited to that which applicant has invented and not to other future aliphatic polyester yarns that might share some of the recited physical properties.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 22-24 stand rejected under 35 U.S.C. 102(a) as being anticipated by JP 2002-180340 A issued to Matsumura et al. as set forth in section 8 of the last Office Action.

Applicant asserts the Petition to Correct Inventorship removes the Matsumura reference as prior art since the inventive entity of said reference is the same as the present application (i.e., not "by others") (Amendment, page 4, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs). The examiner respectfully disagrees since it is not evident that Takehiko Mitsuyoshi of the reference is the same person as Takehiko Miyoshi of the present application. The attorney's notation in the 1<sup>st</sup> paragraph of page 4 of the Amendment is insufficient to establish that the name recited in the Japanese reference is in error. As such, the 102(a) rejection of claims 22-24 stands.

***Claim Rejections - 35 USC § 102/103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 22 stands rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2002-105752 issued to Okawa et al. as set forth in section 10 of the last Office Action.

Applicant traverses the rejection by asserting the Okawa reference is not available as prior art in that the Matsumura reference establishes the date of the present invention as the filing date of Matsumura (i.e., December 18, 2000) (Amendment, page 5, 1<sup>st</sup> paragraph). Since Okawa was not published until April 4, 2002, applicant believes the Okawa reference is not available as prior art (Amendment, page 5, 1<sup>st</sup> paragraph). The examiner respectfully disagrees. First, as discussed above, it has not been clearly established that the Matsumura reference is the work of

the present inventors. Secondly, even if said reference is established to be the work of the present inventors, this in no way establishes the date of the invention as the filing date of the Japanese reference since there is no claim to foreign priority with the Matsumura reference. The effective filing date of the present application remains the filing date of the parent application 10/290,456 which is November 9, 2002. Hence, the Okawa reference is valid as prior art and the rejection is hereby maintained.

### ***Claim Rejections - 35 USC § 103***

13. Claims 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Okawa reference as set forth in section 9 of the last Office Action.

Applicant has presented no new arguments with respect to the 103 rejection of claims 23 and 24. As such, said rejection stands.

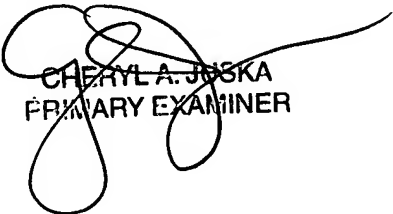
### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1771

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHERYL A. JUSKA  
PRIMARY EXAMINER